

Remarks

This communication is responsive to the Non-Final Office Action of **February 12, 2009**. Reexamination and reconsideration of the claims is respectfully requested.

Status of Claims:

Claims 43-54 are pending for examination.

Claims 43-54 are amended herein.

Claims 43 and 54 are in independent form.

Summary of The Office Action

Claims 43, 48-50 and 52-54 were rejected under 35 USC §103(a) as purportedly being unpatentable over Schmid et al, U.S. Patent No. 6,438,578 (Schmid), in view of Thompson et al, U.S. Patent Publication No. 2002/0077900 (Thompson), in further view of Gupta et al, U.S. Patent No. 6,487,538 (Gupta).

Claims 44-47 were rejected under 35 USC §103(a) as purportedly being unpatentable over Schmid, Thompson and Gupta in view of Bandera et al., U.S. Patent No. 6,332,127 (Bandera).

Claim 51 was rejected under 35 USC §103(a) as purportedly being unpatentable over Schmid, Thompson and Gupta in view of Subramaniam.

Response

The Amended Claims Patentably Distinguish Over the References because the intercepting device maintains the secondary addresses and the intercepting device sends “redirection information” (not secondary content) to the requesting device.

The application as originally filed describes “a way to intercept a user’s initial request (e.g., a web page request) for Internet or other content (e.g., initial content), then ... providing secondary content to that user ... in addition to the initial content. The initial and secondary content may be obtained from different sources such as different web sites. The method also includes a way to extract other information from the initial request and use it as a basis for customizing the secondary content provided to a user.” Page 4, lines 3-9.

The application as originally filed describes how “a communications device intercepts, from a requesting device, an initial request for initial content at the entry point to the Internet...” Page 4, lines 10-12.

The application as originally filed describes how “[a]fter making a determination about what secondary content 165 to provide (e.g., what advertisements), the communications device 110 re-directs the initial request 150 to a secondary content provider 160.” Page 11, lines 9-12. This requires that the address of the secondary content provider be maintained on the communications device 110.

The amended claim recites without transmitting the secondary content to the requesting device. This leaves the decision about whether to request secondary content up to the requesting device. The Office Action asserts that “Thompson discloses that such a feature has the advantage of insuring that a client actually views the advertising content instead of the actual requested content.” The heavy-

handed approach to advertising of Thompson and the other references has lead to a generally unsatisfactory experience, where advertising is rammed down the throat of the user. The amended claim describes determining secondary content that may interest the user and then providing information (e.g., address) concerning the secondary content that the user can, either manually or through configuration settings, decide to view.

Figure1, and the description on page 13, lines 7-23 show how the intercepting computer is making decisions about secondary content to be presented to the user. For example, lines 17-20 recite “the communications device 110 extracts information from the initial request 150 and compares the extracted information to pre-established criteria in order to determine what secondary content 165 should be provided to the client computer system.” Thus, it is the intercepting computer, not a secondary computer, that is deciding what secondary content may be of interest to a user. Conventionally, and in Schmid, the content source or an application associated with the content source makes the decision and always sends the secondary content to the user. Here the decision is made by an intercepting device that is upstream of the content source. The intercepting device therefore needs to know the addresses of the secondary content sources.

The claims have been amended to make more clear that **it is the intercepting device that maintains the secondary addresses** and that transmits the redirection information back to the requesting device. This makes more clear that the decision whether to acquire the secondary content resides with the requesting device rather than with the push model of Thompson.

None of the references, alone and/or in combination, teach the intercepting device maintaining the secondary addresses and then **providing only redirection information**, not secondary content, to the requesting device. The Office Action recites that “there is no language specifying what device needs to maintain access to those addresses.” Page 3, line 2. Now there is language specifying that the

addresses are maintained on the intercepting computer, not on the supplemental content source. The Office Action asserts that Thompson "insures that a client actually views the advertising content instead of the actual requested content." Page 7, paragraph 7. The amended claim provides a much less intrusive approach.

35 U.S.C. §103

To establish a prima facie case of 35 U.S.C. §103 obviousness, basic criteria must be met. The prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.(A) Section 2131 of the MPEP recites how "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). This same standard applies to 103 rejections as evidenced by Section 2143(A) of the MPEP, which reads: "The rationale to support a conclusion that the claim would have been obvious is that **all the claimed elements** were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions".

When establishing a prima facie case of obviousness the Office must clearly articulate the reason(s) the claimed invention would have been obvious. MPEP 2142 recites that:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78

USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at _____, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Additionally, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). This requirement is intended to prevent unacceptable "hindsight reconstruction" where Applicant's invention is recreated from references using the Application as a blueprint.

Here, the criteria for establishing a prima facie case of obviousness are not satisfied since the combination of references does not teach or suggest all the claim limitations. None of the references, alone and/or in combination, teach maintaining, **on an intercepting computer**, access to a plurality of secondary content addresses. Additionally, none of the references, alone and/or in combination, teach **returning redirection information** to the requesting computer. Instead, the combination of references teach secondary addresses on a supplemental content device and automatically transmitting the secondary content. Additionally, none of the references teach including addresses of both the initial content source and at least one secondary content source in redirection information that is provided back to a requesting client. Thus, none of the claims are obvious for at least these reasons.

Claim 50

This claim has been amended to recite a standard Beauregard preamble. The claim includes all the elements of claim 43 and is therefore not obvious for at least the same reasons.

Appln No.: 10/029,667
Filing Date: 10/22/2001
Attorney Docket No. 104348


Applicant(s): CHASE, et al.
Examiner: CHANKONG, DOHM
Group Art Unit: 2452

Conclusion

For the reasons set forth above, the claims are now in condition for allowance. An early allowance of the claims is earnestly solicited.

Respectfully submitted,

Date: April 28, 2009



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